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09/466,640	12/20/1999	LAURA ANNE MAHAN	81395-146	1424

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 02/25/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/466,640

Applicant(s)

MAHAN ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/5/2003 and RCE request of 2/3/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 2,7,12 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16 and 20-40 is/are rejected.
- 7) ☒ Claim(s) 6 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____                                                            | 6) <input type="checkbox"/> Other: _____                                    |

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***Response to Amendment***

This action is responsive to Applicant's RCE request filed February 3, 2004 and amendment submitted on December 5, 2003 (paper # 8 and 10).

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 3, 2004 has been entered. Amended claims 1, 3-6, 8-11, 13-16 and 20-40 are present for examination and claims 2, 7, 12 and 17-19 have been canceled.

***Oath/Declaration***

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over Inventor No. 3 (K. Forbes) signature providing a complete post office address is required.

***Claim Objections***

Claims 6 and 16 are objected to because of the following informalities: they link to canceled claims, however it is presumed claims 6 and 16 are intended to link to claims 1 and 11 respectively. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 8-11, 13-16, 20-22 and 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Vora et al. (U.S. Patent No. 5,623,652).

Regarding claims 1, 8-11, 20 and 29-32, Vora discloses an apparatus and method for associating information with an object in a file (fig. 2, block 201), the apparatus comprising a scheduler (fig. 7B, items 727 and 729) including a component for associating a search key (fig. 7B, keys 726 and 733 with 735) with the object in the file by tagging the object (fig. 6, box 615 and col. 15, lines 20-27), wherein said scheduler is operable to schedule a search for said information using said search key for automatic execution at a pre-scheduled time (fig. 7B, key 726 with 735) by a search interface operable to initiate a pre-scheduled search (fig. 7B), and associating a search result with the tag (fig. 6, 617).

Regarding claims 3, 4, 13 and 14, Vora discloses tagging and labeling objects (fig. 6, box 615 and col. 15, lines 20-27).

Regarding claims 5, 6, 15, 16, 21 and 33, Vora discloses scheduling comprises storing (fig. 1, items 11 and 39) a search key in association with a time of execution at which said search

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is to be executed (fig. 7B, items 726, 733, 727, 729 and 735) and identifying said object (fig. 4A).

Regarding claims 22 and 34, Vora discloses the search comprising a search engine (fig. 2, box 207).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-28 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vora et al. (U.S. Patent No. 5,623,652) in view of Stark (U.S. Patent No. 5,935,210).

Regarding claims 23 and 35 Vora discloses all of the claimed subject matter as discussed above with respect to claims 20 and 32, including an internet server and a gateway (fig. 1, blocks 63 and 61, Vora), but does not expressly teach a search associated with a universal resource locator (URL). However, Stark discloses a mapping structure of a collection of computer resources (title and fig. 4, Stark) where an URL is associated with a search object (fig. 5, items 120, 122, 124 and 126, Vora). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Vora in view of Stark because Vora uses an internet server which could be implemented in view of Stark to associate a URL with an

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object. One of ordinary skill in the art would have been motivated to map URL with objects to link the desired reference of a search.

Regarding claims 24, 28, 36 and 40, Vora/Stark disclose running scripts to populate fields of a search engine (fig. 6A, items 202-214, Stark).

Regarding claims 25-27 and 37-39, Vora/Stark disclose URL and hyperlinks (fig. 5, items 142, 144, 150, 152, 154 and 156, Stark).

### ***Response to Arguments***

Applicant's arguments filed on December 5, 2003 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on pages 13 and 14 of the 12/5/2003 response that there is no disclosure or suggestion of the use of a tag to associate a search key and search results based on the search key with an object in a file.

In response to Applicant's argument, Examiner disagrees. Claim 1 step (d) reads, "associating said search result with said tag, in said file." Examiner notes that Applicant's system derives with said search result from the pre-scheduled search. Figure 3A, Vora discloses and illustrates step 201 of figure 2 previously cited by the Examiner wherein associating (searching) a search key (index) with the object (search request 1) in said file (data searched) is

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performed (fig. 3A, item 315). Note, search request 1 (object) is defined in step 311 and based on this object the index is searched. Further, associating a search key with an object is equivalent to tagging the object with a tag, see Applicant's disclosure (page 3, lines 27-29, Applicant), and disclosed by Vora (fig. 3A, 315 and fig. 6, items 615 and 617, Vora).

Applicant argues on page 15 of the 12/5/2003 response that there is nothing in either reference (Vora and Stark) to suggest that the teachings of the two references should be combined.

In response to Applicant's argument, Examiner disagrees. Vora is a searching system that uses pointers for searchable information (fig. 2, item 205, Vora) and uses a server over the internet (fig. 1, Vora), and Stark is a mapping system concerned with creating and searching URLs (abstract, Stark). Both systems search the internet, and since searching the internet was common and notoriously well known at the time the invention was made, Examiner notes that Vora in view of Stark are clearly obvious when used in combination.

With respect to all the pending claims 1, 3-6, 8-11, 13-16 and 20-40, Examiner respectfully traverses Applicant's assertion based on the discussion cited above.

### ***Conclusion***

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156. The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF  
February 24, 2004

  
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